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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,687	10/17/2003	Dean Willberg	56.0758	2686

27452 7590 10/26/2006

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EXAMINER

KUGEL, TIMOTHY J

ART UNIT PAPER NUMBER

1712

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,687

Applicant(s)

WILLBERG ET AL.

Examiner

Timothy J. Kugel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5, 6, 8-10, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 10, 15 and 16 is/are rejected.
- 7) ☒ Claim(s) 1, 5, 6, 8-10, 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 5, 6, 8-10, 15 and 16 are pending as amended on 12 October 2006, claims 2-4, 7 and 11 being cancelled.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Due to a reference that has come to the attention of the examiner, the finality of the rejection of the last Office action is withdrawn.

Claim Objections

4. Claims 1, 5, 6, 8-10, 15 and 16 objected to because of the following informalities: claim 1 recites, "provided that the mixture of the solid acid-precursor and the solid acid-reactive material are not a combined mixture" and should recite, "provided that the mixture of the solid acid-precursor and the solid acid-reactive material are is not a combined mixture". Appropriate correction is required.

Claim Rejections - 35 USC § 102 and 35 USC § 103

5. Applicant's amendment, filed 12 October 2006, with respect to limiting the composition to not being a combined mixture—as defined in the specification as being one or more solid acid-precursors and one or more solid acid-reactive materials is in each particle—has been fully considered and overcomes the prior art.

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The rejection of claims 1, 5, 10 and 15 under 35 U.S.C. 102(b) as being anticipated by US Patent 4,986,354 (Cantu '354 hereinafter) has been withdrawn.

The rejection of claims 6 and 16 under 35 U.S.C. 103(a) as being unpatentable over Cantu '354 has been withdrawn.

The rejection of claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Cantu '354 in view of US Patent 5,325,921 (Johnson hereinafter) has been withdrawn.

6. Claims 1, 10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,585,482 (Tice hereinafter).

Tice teaches a composition comprising a solid chlorine dioxide-liberating compound such as sodium chloride and a solid acid-generating compound such as poly(lactic acid) wherein the solid acid-generating compound may be encapsulated within a film-forming polymer and wherein the composition generates chlorine dioxide in the presence of water (Abstract, Column 2 Lines 26-32 and 50-62, Column 3 Lines 3-29 and Column 4 Line 66 – Column 5 Line 17).

Regarding the limitation "An oilfield treatment composition" in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Since the composition of Tice is capable of performing the intended use, it meets the claim.

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7. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Tice as applied to claims 1, 10 and 16 above as evidenced by <http://chemfinder.cambridgesoft.com/result.asp> for sodium chlorite, accessed 24 October 2006 (ChemFinder hereinafter).

Tice teaches a composition comprising a solid chlorine dioxide-liberating compound such as sodium chloride and a solid acid-generating compound such as poly(lactic acid) wherein the solid acid-generating compound may be encapsulated within a film-forming polymer and wherein the composition generates chlorine dioxide in the presence of water as detailed above.

ChemFinder shows that sodium chlorite is soluble in water (Page 1).

8. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being unpatentable over Tice.

Tice teaches a composition comprising a solid chlorine dioxide-liberating compound such as sodium chloride and a solid acid-generating compound such as poly(lactic acid) wherein the solid acid-generating compound may be encapsulated within a film-forming polymer and wherein the composition generates chlorine dioxide in the presence of water as detailed above.

Since Tice teaches the same composition as claimed, one of ordinary skill in the art at the time the invention was made would have expected that the capability of the Tice composition to form a filter cake would inherently be the same as claimed.

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Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103. "There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977).

Allowable Subject Matter

9. Claims 6, 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Tice fails to teach a substantially water insoluble acid-reactive compound or boric acid or borax as the acid-reactive compound.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached 6:00 AM – 4:30 PM Monday - Thursday.

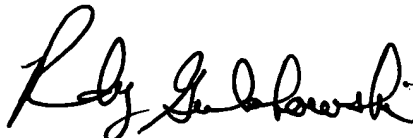
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TJK
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RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700